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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,015	11/21/2003	Ling Tong	AL01562K	5656

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SCHERING-PLOUGH CORPORATION
PATENT DEPARTMENT (K-6-1, 1990)
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EXAMINER

DAVIS, ZINNA NORTHINGTON

ART UNIT PAPER NUMBER

1625

DATE MAILED: 01/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/721,015

Applicant(s)

TONG ET AL.

Examiner

Zinna Northington Davis

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) 41-56 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-26 and 28-40 is/are allowed.
- 6) ☒ Claim(s) 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 01/04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

1. Claims 1-56 are pending.
2. This action is in response to the Communication filed October 28, 2005. In the response, Applicants elect Group I, claims 1-40 with traverse. Example 9 is the preferred species.

Response to Applicant' s Traversal of the Requirement for Restriction

Applicants state that the method claims 41, 42, and 55 depend from claim 1. Applicants fail to understand how the claimed methods of using the claimed compounds can be used to support the Office's allegation that the compounds of Group I can be used in a materially different process. Accordingly, this basis of restriction is improper and the requirement for restriction should be withdrawn.

It is the examiner's position that:

- Claim 41 is drawn to a method of modulating a receptor.
- Claim 42 is drawn to a method of treating various diseases.
- Claim 55 is drawn to treating multiple sclerosis.
- These various methods of treating are unrelated. As such, each method would support separate patents.
- Additionally, WO98/00412 teaches a class of compounds, which are similar to the instantly claimed compounds. These compounds are useful in the treating of cognitive disorder.

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- Based upon multiple methods of treating using the instant compounds, the restriction is deemed proper.

Applicants respectfully request submit that the claimed methods of Groups II-VII should be rejoined if Claim 1 is found allowable (MPEP § 821.04) as each of the claims in these Groups depend either directly or indirectly from claim 1, and therefore include all the limitations thereof.

It is the examiner's position that:

- Claim 1 is found allowable.
- The claims will be rejoined.
- Applicants are requested to elect **one Group** to be examined with the invention of Group I.
- The elected Group must meet the requirements of 35 U.S.C. 101, 102, 103, and 112. Claim 42 does not meet the requirements of 35 U.S.C. 112.
- Claim 56 (kit) will also be rejoined with the elected invention.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 27 should end in a period.

4. Claims 1-26 and 28-40 are allowed.

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5. The Information Disclosure Statement filed July 30, 2004 cites the Search Report. The Search Report has been considered, but will not be listed on any patent resulting from this application because they were not provided on a separate list in compliance with 37 CFR 1.98(a)(1). In order to have the references printed on such resulting patent, a separate listing, preferably on a PTO/SB/08A and 08B form, must be filed within the set period for reply to this Office action.
6. Based upon the Search Report, WO 98/00412 has been cited as a Category X. This examiner does not consider this reference as a X reference. The reference does not teach $-M^1-L^2-M^2$ as suggested by the instant claims. There is neither teaching nor suggestion to modify the prior art compounds to derive those instantly claimed.
7. The Information Disclosure Statement filed January 26, 2004 has been considered. The prior art references alone or in combination form do not teach nor suggest structurally similar compounds as those instantly claimed. Accordingly, no rejections based upon prior art are made.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zinna N. Davis whose telephone number is 571-272-0682.
9. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 for regular communications.
10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Zinna Northington Davis
Primary Examiner
Art Unit 1625

Znd
01.19.2006